

REMARKS

Status of the Claims

No claim amendments are provided herein. Therefore, Claims 2-16, 18-23, 25-26, 29, and 31 are currently pending and under examination. All claims were rejected in the Final Office Action mailed June 7, 2006.

Summary of Telephonic Interview with Patent and Trademark Office

On July 5, 2006, Examiner Cole of the Patent and Trademark Office (“PTO”) participated in a telephonic interview with Applicants’ undersigned representative. Present with the undersigned was Mr. Todd J. Obijeski. Parties discussed the Final Office Action, dated June 7, 2006. Regarding the §112 rejection, Applicants’ representative identified that support for the terminology in independent Claims 26 and 29 is found in the specification at least at page 3, second full paragraph; page 10, first full paragraph; and Fig. 1. Examiner Cole indicated that she would withdraw the §112 rejection. Regarding the §103(a) rejection, Examiner Cole indicated that her interpretation of JP 07-011755 to Tajima (“*Tajima*”) was that (1) the fabric in Drawing 5 “inherently” provides reinforcement, and (2) a “closed layer” is formed around the fabric in Drawing 5. Respectfully, Applicants’ representatives disagreed with this interpretation on both points. Thus, no agreement was reached regarding the §103(a) rejection. Applicants and their representatives thank Examiner Cole for her courtesy in conducting this interview. Examiner Cole provided an interview summary, mailed July 17, 2006.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 2-16, 18-23, 25-26, 29, and 31 are rejected by PTO under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Specifically, the PTO stated that the specification of the pending application does not provide support for the feature

that the coating compounds form a closed layer around the at least one reinforcement material. Respectfully, Applicants traverse this rejection.

As indicated above, Applicants' representatives discussed this rejection with the PTO during a telephonic interview on July 5, 2005, and the PTO agreed to withdraw this rejection. Specifically, Applicants discussed the fact that support for this language is found in the specification at least at page 3, second full paragraph; page 10, first full paragraph; and Fig. 1. Accordingly, Applicants respectfully request that the rejection of Claims 2-16, 18-23, 25-26, 29, and 31 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Rejection Under 35 U.S.C. § 103(a)

Claims 2-16, 18-23, 25-26, 29, and 31 are rejected by the PTO under 35 U.S.C. § 103(a) as being obvious over JP 07-011755 to Tajima ("Tajima") in view of U.S. Patent No. 5,932,337 to Edinger et al. ("Edinger"). Applicants respectfully traverse this rejection for at least the following reasons.

According to MPEP § 2142, in order to establish a *prima facie* case of obviousness, three (3) criteria must be met:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the references;
2. There must be a reasonable expectation of success; and
3. The prior art references must teach or suggest all the limitations of the claim.

Respectfully, Applicants maintain that the PTO has failed to provide a rationale supporting a *prima facie* case for obviousness under 35 U.S.C. 103(a).

1. There is no suggestion or motivation to modify or combine the references as the PTO states.

(a) On pages 4-5 of the Office Action, Section 7, the PTO states that the motivation to combine the references is found in the fact that both *Tajima* and *Edinger* relate to flooring

materials and *Edinger* discloses particular resins for use in making floor tiles which have advantageous properties. Respectfully, Applicants maintain that the PTO's stated rationale is not sufficient to support *prima facie* obviousness by combining these references as the PTO has done.

Legal precedent requires that finding a combination obvious requires some suggestion, motivation, or teaching in the prior art to select the teachings of separate references and combine them in the way that would produce the claimed combination. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed.Cir.2001). The fact that *Tajima* and *Edinger* both relate to flooring materials is not sufficient to establish a *prima facie* determination of obviousness. According to the Federal Circuit, “[w]hen the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.” (Emphasis Added). *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998).

Respectfully, Applicants maintain that the mere fact that both *Tajima* and *Edinger* relate to flooring materials is not sufficient to combine these references, absent the identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. Respectfully, Applicants assert that the PTO has failed to identify this motivation.

(b) On page 3 of the Office Action, Section 4, the PTO states that it would have been obvious to one or ordinary skill in the art at the time the invention was made to employ the resin composition of *Edinger* instead of the PVC used in *Tajima*'s surface decorative layer. The PTO cites as motivation the expectation to produce an article without a negative impact on the environment, i.e., without using PVC. While the PTO points to *Edinger*'s statement regarding PVC materials as providing motivation (Office Action section 4, p. 3), such as statement fails to identify the suggestion, teaching, or motivation that would lead the skilled artisan to select the

teachings of separate references and combine them in the way the PTO has proposed. Specifically, the skilled artisan using *Edinger*'s resins would **not** look to *Tajima* for providing some sort "reinforcing component" as the PTO states (Office Action section 3, p. 2), for at least the reason that *Edinger* discloses a cover coat having "high mechanical strength" and therefore provides no incentive to search for any "reinforcing component" (col. 4, lines 32-29). Further, the skilled artisan using *Tajima*'s flooring materials would **not** look to *Edinger* for providing non-PVC resins as the PTO states (Office Action section 4, p. 3), for at least the reason that *Tajima* already discloses non-PVC resins such as "polyester resin, ultraviolet ray curing type resin or the like" (Abstract), and therefore provides no incentive to search for non-PVC resins.

Moreover, the present disclosure makes no mention of eliminating PVC for environmental reasons, has no stated goal or purpose of replacing PVC, nor is in any way limited to non-PVC compositions. The rejected Claims 8-16, 20-21, 23, and 31 depend from Claim 29, which is drawn to materials that can include PVC. In fact, the specification provides for a flexible flat multilayer material and a process for making said material that can include PVC. For example, PVC specifically is mentioned in the specification in at least the following locations: page 2, first full paragraph; page 4, last paragraph, carrying over to page 5, first paragraph; page 12, second full paragraph; and page 13, second full paragraph describing Fig. 3. Respectfully, Applicants submit that there is no support for the PTO's stated motivation or reason to combine these references.

(c) On pages 3-4 of the Office Action, Section 4, the PTO states that with regard to the recitation of additional layers, *Edinger* indicates that flooring tiles can comprise multiple **reinforcing** layers, and therefore, it would have been obvious to have additional layers to the material of *Tajima* in order to further **reinforce** the tile material of *Tajima*. (Emphasis added). Respectfully, Applicants maintain that *Edinger* does not stand for the proposition for which it is cited and relied upon by the PTO, therefore the PTO has not provided a proper rationale for combining these reference.

Edinger does not disclose that flooring tiles can comprise multiple **reinforcing** layers as disclosed in the present invention. There is no statement in the whole of *Edinger* regarding nonwoven or fabric **reinforcing** layers. Likewise, there is no statement in the whole of *Tajima* regarding a **reinforcing** material. There are no means or methods to achieve **reinforcement** using nonwoven or fabric materials in the disclosure of either *Edinger* or *Tajima*. Applicants respectfully assert that these two references cannot be combined to support a rejection of obviousness based on a **reinforcement** material when neither reference makes ANY mention of a reinforcement material, absent hindsight.

Further, Applicants submit that it is well established that hindsight is not permitted in a *prima facie* showing of obviousness. As the Federal Circuit has stated, “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

For at least these reasons, Applicants assert that the PTO has not provided a convincing line of reasoning why one of ordinary skill in the art would have combined or modified the references as the PTO has done to derive the claimed invention. Respectfully, Applicants assert that a *prima facie* case of obviousness has not been made.

2. There is no reasonable expectation of success to modify or combine the references to produce the claimed invention.

(d) On page 2 of the Office Action, Section 3, the PTO states that, “since the fabric functions as a **decorative** and **reinforcing** component in the tile of JP ‘755 [*Tajima*] it would have been obvious to one of ordinary skill in the art to have selected the basis weight through the process of routine experimentation...” (Emphasis Added). Respectfully, Applicants maintain that *Tajima* does not support this proposition relied upon by the PTO, therefore *Tajima*, either

alone or in combination with *Edinger*, does not provide a reasonable expectation of success to modify or combine the references to produce the claimed invention.

As noted earlier, there is no statement in the whole of *Tajima* regarding a **reinforcing** material. The PTO's statement regarding a **reinforcement** material does not originate from the disclosure of *Tajima*; rather, *Tajima* is directly entirely to **decorative** flooring materials and makes no mention of **reinforcement**. *Tajima* is drawn to a flooring "which can express the pattern of a carpet design...." See paragraph [0003]. *Tajima*'s fabric functions solely as a **decorative** fabric. Respectfully, Applicants assert that there no reasonable expectation of success to modify or combine references when the references relied upon by the PTO are completely silent with regard to a reinforcing material. Thus, if any experimentation would be required as stated by the PTO, such experimentation would be "undue experimentation."

(e) On page 4 of the Office Action, Section 5, the PTO states that "the presence of the fabric layer in the resin layer would **necessarily reinforce** the layer," and that it is "notoriously well known...that **any fabric** which is embedded in a resin material is a **reinforcement** for the resin material." (Emphasis Added). Respectfully, Applicants assert that this proposition relied upon by the PTO is without support.

As indicated in the Office Action, the PTO proposes that the fabric in Drawing 5 necessarily and automatically provides reinforcement (Office Action, Section 5, page 4). The PTO has provided no support for the proposition that any decorative fabric must inherently provide reinforcement. According to MPEP § 2112 (IV):

"The fact that a certain result may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (Emphasis in original). Further, the MPEP provides "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that would be so recognized by persons of ordinary skill. Inherency, however, may not be established by

probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "

Thus, Applicants submit that the PTO has provided no support for the proposition that any decorative fabric must inherently provide reinforcement. Further, there is no disclosure in *Tajima* to support this theory of inherency. Absent a factual showing of inherency, Applicants assert that there is no reasonable expectation of success to modify *Tajima*, or to combine *Tajima* with any other reference, when there are no facts in the record or in the prior art to indicate that selecting **any fabric for decorative purposes** would necessarily provide the **flat material with reinforcement** of the present invention.

For at least these reasons, Applicants assert that the PTO has not provided a convincing line of reasoning why one of ordinary skill in the art, at the time the present invention was made, would have a reasonable expectation of success to modify or combine the references as the PTO has done to derive the claimed invention. Respectfully, Applicants assert that a *prima facie* case of obviousness has not been made.

3. The prior art references do not teach or suggest all of the limitations of the claimed invention.

(f) On page 4 of the Office Action, Section 6, the PTO states that "Figure 5 clearly shows that the fabric is within or embedded in the resin." During the telephonic interview, Applicants confirmed that the PTO's interpretation of *Tajima* is that a "closed layer" is formed around the fabric in Drawing 5. Respectfully, Applicants assert that the PTO's interpretation of Drawing 5 is completely inconsistent with *Tajima*'s disclosure.

Applicants' claimed reinforcement material is substantially completely surrounded by at least one coating compound so that a closed layer is formed around the reinforcement material. See e.g., page 3, second full paragraph; page 11, second full paragraph; and Fig. 1. In sharp contrast, *Tajima* states in the abstract that a "...synthetic resin is impregnated into a coloured

fibre aggregate comprising a nonwoven fabric." (Emphasis Added). See also "impregnation" in *Tajima* paragraph [0013]. There is no indication in the disclosure of the *Tajima* reference that the impregnation results in a closed layer being formed around the fabric of *Tajima*. In comparing Fig. 1 of the present invention and Drawing 5 of *Tajima*, Applicants assert that *Tajima* does not fairly teach or suggest, to one of ordinary skill in the art, the claimed invention. Accordingly, *Tajima* does not teach or suggest substantially completely surrounding a reinforcement material so that a closed layer is formed, and therefore, does not teach or suggest all of the features of the claimed invention.

(g) Additionally, neither *Tajima* nor *Edinger*, either alone or in combination, teach or suggest either (I) a flat reinforcement material, or (II) a nonwoven material with a weight in a range from 9 to 50 g/m² as claimed in the independent claims. As described above, there is no mention in either reference of a reinforcement material and the PTO has provided no basis in fact to support a theory of inherency. In addition, there is no mention in either reference of a reinforcing nonwoven material with a weight in a range from 9 to 50 g/m². Further, the means to achieve this particular nonwoven material weight range are not disclosed in either *Tajima* or *Edinger*, explicitly or implicitly. Respectfully, Applicants note that the Federal Circuit has reversed a rejection based on obviousness because the PTO based its inherency argument "on what would result due to optimization of conditions, not what was necessarily in the prior art." *In re Rijckaert*, 9 F.3d 1531, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993). See also MPEP § 2112 (IV).

For at least these reasons, Applicants assert that even if the references were combined in the manner that the PTO proposes, this combination of references fails to teach or suggest all of features of the claimed invention. Respectfully, Applicants assert that a *prima facie* case of obviousness has not been made. Accordingly, Applicants respectfully request that the rejection of Claims 2-16, 18-23, 25-26, 29, and 31 under 35 U.S.C. § 103(a) over *Tajima*, in view of *Edinger*, be withdrawn and these claims allowed.

Rejection of Claims 20-21 and 25 Under 35 U.S.C. § 103(a)

Dependent Claims 20-21 and 25 are directed to an aspect of the invention wherein one or more flat nonwoven materials are additionally located under the at least one cover layer. In addition to the reasons discussed above, Applicants respectfully traverse the rejection of these claims under §103(a) for the following reasons.

(h) On pages 3-4 of the Office Action, Section 4, the PTO states that with regards to the recitation of additional layers, *Edinger* discloses that flooring tiles can comprise **multiple reinforcing** layers, and therefore, it would have been obvious to have **additional layers** to the material of *Tajima* in order to further **reinforce** the tile material of *Tajima*. (Emphasis added). Respectfully, Applicants assert that this proposition relied upon by the PTO is without support.

According to MPEP § 2143.01 (V), if a “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” The purpose of *Tajima*, as stated in the abstract, is “[T]o increase the feeling of high grade and also **reduce cost** by providing a **surface decorative layer** consisting of colored fiber dispersed in transparent or semi-transparent synthetic resin.” (Emphasis Added). Adding one or more flat nonwoven materials additionally under the at least one cover layer would frustrate the purpose of *Tajima*. First, the additional flat nonwoven would not be visible under the surface decorative layer already having a fabric as illustrated in Drawing 5 of *Tajima*. The additional nonwoven material would serve no decorative purpose. Second, the addition of another flat nonwoven material would increase the cost wherein the decorative purpose is already achieved by the presence of a fabric in the surface decorative layer. Hence, the proposed modification by combining these references would defeat the intended purpose of *Tajima*, and therefore Applicants respectfully maintain that this rejection of Claims 20-21 and 25 under 35 U.S.C. § 103(a) is not supported. Accordingly, Applicants respectfully request that this rejection be withdrawn and these claims allowed.

CONCLUSION

The foregoing is submitted as a full and complete Response to the Final Office Action dated June 7, 2006. For at least the reasons given above, Applicants respectfully submit that Claims 2-16, 18-23, 25-26, 29, and 31 define patentable subject matter. Accordingly, Applicants request allowance of these claims.

This Response is being filed within two (2) months of the final action, therefore Applicants request that an Advisory Action be issued in this case.

No fees are believed due, however, the Commissioner is hereby authorized to charge any deficiencies which may be required, or credit any overpayment to Deposit Order Account No. 09-0528.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,



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